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10/066,756

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Tatsuaki Osafune

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EXAMINER

REED SMITH LLP

3110 FAIRVIEW PARK DRIVE, SUITE 1400

FALLS CHURCH, VA 22042

SCUDERI, PHILIP S

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,756

Applicant(s)

OSAFUNE ET AL.

Examiner

Philip S. Scuderi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 2 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Drawings***

1. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 307, 705, 811, 822, 823, 832, 833, 1001, 1106, 1303, and 1304. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the

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examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The disclosure is objected to because the reference the PC using reference number 111 on p. 3 line 25 is invalid. Examiner suggests using reference number 211.
4. The disclosure is objected to because the reference to private address "a.b.c.d" using reference number 512 on p. 12 line 15 is invalid. Examiner suggests using reference number 521.
5. The disclosure is objected to because the reference to global address "f.g.h.i" using reference number 831 on p. 16 line 7 is invalid. Examiner suggests using reference number 931.

Claim Objections

6. Claim 2 is objected to because the claim recites the limitation "both items" in line 8. It is likely that applicant is referring to the user ID and the second network address, however there is insufficient antecedent basis for this limitation in the claim. Examiner suggests "said user ID and said second network address". Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claim 3 recites the limitation "said user ID". There is insufficient antecedent basis for this limitation in the claim.
9. Claim 5 recites the limitation "said communication between said user computer and a server". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-4, 7, and 10 are rejected under 35 USC § 102 as being anticipated by Prior Art admitted by applicant [Specification p. 1-4, figures 1-2, hereinafter "Admitted Art", see MPEP 2129].

12. With respect to claim 1, Admitted Art discloses a method for providing a data communication service, which enables a user computer [fig. 2 #211] to be connected to an Internet service provider [fig. 2 #203] via a network [fig. 2 #201-203] and

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communication between said user computer and said Internet service provider to be established [p. 3 lines 22-24], said method comprises;

a step of holding a first network address assigned to said user computer from said Internet service provider and translating a second network address sent from said user computer to said first network address [The ISP holds the global address discussed in p. 4 lines 17-20. By translating the source IP address into the global address as discussed in p. 4 lines 17-20 the ISP is assigning the global IP address to the user computer.]; and

a step of establishing communication between said user computer and said Internet service provider [p. 3 lines 22-24].

13. With respect to claim 2, Admitted Art discloses the method applied to claim 1. Admitted Art further discloses the method further including:

a step of allowing said network to give said second network address to said user computer [p. 4 lines 11-14];

a step of allowing said network to hold a user ID [p. 4 lines 8-10] used to identify said user computer and said second network address [p. 4 lines 10-14] so that both items are related to each other [The RAS server distributes the private IP address to the user after authenticating the user.];

a step of allowing said network to issue a user authentication request to said Internet service provider [p. 4 lines 8-10]; and

a step of allowing said network to hold said first network address assigned to said user computer from said Internet service provider [As discussed in p. 4 lines 17-20 the

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network translates the source address into the global address, therefore the network must hold the global address.].

14. With respect to claim 3, Admitted Art discloses the method applied to claim 1. Admitted Art further discloses that said user ID [p. 4 lines 8-10, PC 211 holds the user ID.], said first network address [p. 4 lines 17-20, NAT 233 holds the global address.], and said second network address [p. 4 lines 11-14, PC 211 holds the private address.] are held so that they are related to each other [They are related to each other by being held in the same network (fig. 2 #201-203).].

15. With respect to claim 4, Admitted Art discloses the method applied to claim 1. Admitted Art further discloses that said second network address sent from said user computer is an address described in a network address field in a communication packet [p. 4 lines 14-17].

16. With respect to claim 7, Admitted Art discloses a network [fig. 2 #201-203] for connecting a user computer [fig. 2 #211] to an Internet service provider [fig. 2 #203]; wherein said network holds user identification information used to identify said user computer [p. 4 lines 8-10], a private address assigned to said user computer from said network [p. 4 lines 11-14], and a global address assigned to said user computer from said service provider [The ISP holds the global address discussed in p. 4 lines 17-20. By translating the source IP address into the global address as discussed in p. 4 lines 17-20 the ISP is assigning the global IP address to the user computer.].

17. With respect to claim 10, Admitted Art discloses the network applied to claim 7.

Admitted Art further discloses that said network includes:

an address translation gateway provided with a table for holding a set of user identification information used to identify said user computer [fig. 2 #232, p. 4 lines 8-10], a private address assigned to said user computer from said network [p. 4 lines 11-14], and a global address assigned to said user computer from said Internet service provider [The ISP holds the global address discussed in p. 4 lines 17-20. By translating the source IP address into the global address as discussed in p. 4 lines 17-20 the ISP is assigning the global IP address to the user computer.]; and

an access server for requesting said address translation gateway for said private address upon receiving said user identification information and a password from said user computer [fig. 2 #231, p. 4 lines 10-11].

18. Claims 1-5, 8, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Schmuelling et al. [U.S. 6,603,758, hereinafter "Schmuelling"].

19. With respect to claim 1, Schmuelling discloses a method for providing a data communication service, which enables a user computer [fig. 1 #127] to be connected to an Internet service provider [fig. 1 #106, 116, The combination of Internet 116 and ISP 106 can be considered an Internet service provider. ISP 116 provides an IP address and Internet 106 provides access to web pages etc.] via a network [fig. 1] and communication

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between said user computer and said Internet service provider to be established [col. 4 lines 61-67], said method comprises;

a step of holding a first network address assigned to said user computer from said Internet service provider [col. 4 lines 56-59] and translating a second network address sent from said user computer to said first network address [col. 4 lines 59-64]; and

a step of establishing communication between said user computer and said Internet service provider [col. 4 lines 61-67].

13. With respect to claim 2, Schmuelling discloses the method applied to claim 1. Schmuelling further discloses the method further including:

a step of allowing said network to give said second network address to said user computer [col. 4 lines 59-61];

a step of allowing said network to hold a user ID [col. 4 lines 59-61, A local IP address identifies a user and is therefore a user ID.] used to identify said user computer and said second network address [col. 4 lines 59-61] so that both items are related to each other [They are the same entity.];

a step of allowing said network to issue a user authentication request to said Internet service provider [col. 4 lines 56-57, Receiving a routable IP address from an ISP comprises issuing a user authentication request.]; and

a step of allowing said network to hold said first network address assigned to said user computer from said Internet service provider [As discussed in p. 4 lines 17-20 the network translates the source address into the global address, therefore the network must hold the global address.].

14. With respect to claim 3, Schmuelling discloses the method applied to claim 1. Schmuelling further discloses a user ID [col. 4 lines 59-64, A local IP address identifies a user and is therefore a user ID.], said first network address [col. 4 lines 56-59], and said second network address [col. 4 lines 59-64] are held so that they are related to each other [They are related to each other by being held in the network of figure 1.].

15. With respect to claim 4, Schmuelling discloses the method applied to claim 1. Schmuelling further discloses that said second network address sent from said user computer is an address described in a network address field in a communication packet [col. 4 lines 61-64, Communication packets are translated by modem 128.].

20. With respect to claim 5, Schmuelling discloses the method applied to claim 1. Schmuelling further discloses that said communication between said user computer and said Internet service provider is established according to said first network address [col. 4 lines 61-64] while said communication between said user computer and a server [fig. 1 #128] is established according to said second network address [col. 4 lines 59-61].

22. With respect to claim 7, Schmuelling discloses a network [fig. 1] for connecting a user computer [fig. 1 #127] to an Internet service provider [fig. 1 #106, 116, The combination of Internet 116 and ISP 106 can be considered an Internet service provider. ISP 116 provides an IP address and Internet 106 provides access to web pages etc.];

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wherein said network holds user identification information used to identify said user computer [col. 4 lines 59-61, A local IP address is user identification information], a private address assigned to said user computer from said network [col. 4 lines 59-61], and a global address assigned to said user computer from said service provider [col. 4 lines 56-59].

23. With respect to claim 8, Schmuelling discloses the network applied to claim 7. Schmuelling further discloses that said global address is used to access said Internet service provider [col. 4 lines 61-64] and said private address is used to access a server in said network [col. 4 lines 59-61, Modem 128 is a server that serves local IP addresses.].

24. With respect to claim 9, Schmuelling discloses the network applied to claim 8. Schmuelling further discloses that said private address is translated into said global address to access said Internet service provider [col. 4 lines 61-67].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schmuelling.

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21. With respect to claim 6, Schmuelling discloses an address translation apparatus [fig. 1 #128] connected to plural user computers [col. 4 lines 59-61] and plural Internet service providers [fig. 1 #116-120] via a network [fig. 1], said apparatus being used to communicate with an authentication server [fig. 1 #148] installed in a network of an Internet service provider [fig. 1 #116], store a network address assigned to said user computer [col. 4 lines 56-61], translate at least one of source and destination network addresses described in a field in a communication packet [col. 4 lines 61-64], and transfer said translated network address [col. 4 lines 61-64];

wherein a network address assigned to each user computer [col. 4 lines 59-61] and a network address assigned to said user computer from an Internet service provider [col. 4 lines 56-59] that has received a connection request from said user computer makes a pair and said address translation apparatus holds said pair of network addresses [col. 4 lines 59-64], so that said apparatus, when receiving a packet that describes one of said held paired network addresses, translates one of said held paired network addresses, then transfers said translated network address [col. 4 lines 59-64].

In the embodiment disclosed in col. 4 line 56+ Schmuelling does not expressly disclose authenticating a user when a connection request is issued from a user computer to said Internet service provider. Nonetheless, Schmuelling discloses authenticating a user when a connection request is issued from a user computer to said Internet service provider in col. 4 lines 32-37. Given the further teachings of Schmuelling it would have been obvious to one of ordinary skill in the art to authenticate a user when a connection request is issued from a user computer to said Internet service provider. The motivation

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for doing so would have been so that ISP 116 would receive the appropriate credentials to issue the routable IP address to modem 128 as discussed in col. 4 lines 56-59.

Conclusion

25. The following art made of record is considered pertinent to applicant's disclosure:


Johnson et al. [U.S. Application Publication 2003/0172170].

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 8am-5pm.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (703) 305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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